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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,714	06/04/2001	Morenike Awokola	FA1002 US NA .	4978

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WILMINGTON, DE 19805

EXAMINER

TSOY, ELENA

ART UNIT PAPER NUMBER

1762

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/873,714	AWOKOLA ET AL.	
	Examiner	Art Unit	
	Elena Tsoy	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004 .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

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Response to Amendment

1. Amendment filed on November 26, 2004 has been entered. Claim 9 has been cancelled. Claims 1-6, 8, 10, 13 are pending in the application.

Claim Objections

2. Objection to claim 9 under 37 CFR 1.75(c) has been withdrawn due to cancellation of the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-6, 10, 13** rejected under 35 U.S.C. 103(a) as being unpatentable over DE-A-197 57 082 or WO 99/26733 in view of Richard (US 5,091,211) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on July 23, 2004.

5. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over DE-A-197 57 082 or WO 99/26733 in view of Richard (US 5,091,211), further in view of Brehm et al (US 5,596,043) for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on July 23, 2004.

Response to Arguments

6. Applicants' arguments filed November 26, 2004 have been fully considered but they are not persuasive.

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(A) Applicants argue that Richard is in fact directed to an improvement in coating of synthetic plastic substrates. The Examiner's attention is respectfully directed to the entire paragraph beginning at column 1, line 55 of Richard. The cited text states that while the "coating compositions of the invention are known to provide strong adhesive bonds to metal substrates, the same coatings have failed to provide bonds of satisfactory strength on synthetic plastic substrates." (Emphasis added). The Examiner has misinterpreted this statement as applying to the claimed invention of Richard, when in fact the statement applies to previously known own compositions- i.e., compositions not containing at least one phosphoric acid group and containing at least one free-radically polymerizable double bond, as recited in the present claims. let alone compositions containing the other features of the present claims. For support of Applicant's interpretation of the cited lines from Richard, Applicant directs the Examiner to the abstract, which recites the invention as being an "improvement" to a method of coating a vinyl resin layer with a coating composition

The Examiner respectfully disagrees with this argument. Richard teaches: "In a method of coating a vinyl resin layer with a coating composition comprising a radiation-curable acrylourethane, a photoinitiator and an addition-polymerizable monomer polymerizable with said acrylourethane and radiation curing the coated vinyl resin layer, it has been found that an improvement in bond strength can be obtained by including in said coating composition, prior to curing, a sufficient amount of a monoester or diester of *phosphoric acid*. A surprising feature of the invention involves the discovery that while the coating compositions of **the invention** are known to provide strong adhesive bonds to metal substrates, the same coatings have failed to provide bonds of satisfactory strength on synthetic plastic substrates" (See column 1, lines 46-

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60). (Emphasis added). Note that a second paragraph follows directly a first paragraph.

Therefore, “**the invention**” in the second paragraph relates to *an improved coating composition* of the first paragraph not to *previously known own compositions* - i.e., compositions not containing at least one phosphoric acid group and containing at least one free-radically polymerizable double bond. This is evident if only from the fact that there is no reference to any of their previous patents and/or publications. Moreover, it is well known in the art that *phosphoric acid* is commonly added to coating compositions for improving adhesion to metal surfaces. See, for example, abstracts of JP 51030544, JP 05247155, JP 61076516, JP 61152713, JP 2000154336 (these references are applied here not as a new ground of rejection but to show the state of art only).

(B) Applicants argue that the "automobile parts" referred to in Brehm are made of thermoplastic materials, and, accordingly, there is no reason for a person of ordinary skill in the art to conclude that the coatings of Brehm, even including isobornyl methacrylate, are suitable for use in coating metal substrates. Brehm, in combination with Richard, does not disclose or suggest any coatings of metal substrates and there is no suggestion in either Brehm or Richard that the compositions disclosed therein are suitable for coating metal substrates, as recited in the present claims. Accordingly, Applicant submits that the combination of Maag with Richard and/or Brehm fails to disclose, teach, or suggest claim 8 of the present application and that Claim 8 is not obvious over Maag, Richard and/or Brehm, alone or in combination.

The Examiner respectfully disagrees with this argument. Brehm et al is a secondary reference which is relied upon to show that monofunctional reactive thinners, such as isobornyl methacrylate (See column 5, line 59) may be used in combination with acrylic prepolymers (See

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column 4, lines 5-13) in a radiation curable coating composition (See column 7, lines 14-25) for coating automobile parts (See column 6, lines 33-35, 42) to provide **good flow properties** of the coating composition and thereby **good processibility** (See column 5, lines 50-53). Clearly, Brehm would provide the coating compositions of DE-A-197 57 082/WO 99/26733 in view of Richard with **good flow properties** of the coating composition and thereby **good processibility** no matter to what kind of substrates the coating compositions should be applied.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER
ETsoy

January 10, 2005